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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,084	03/12/2007	Volker Gedenk	1024943-000215	6307

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EXAMINER

SMITH, JASON C

ART UNIT	PAPER NUMBER
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3617

NOTIFICATION DATE	DELIVERY MODE
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07/06/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/594,084	Applicant(s) GEDENK ET AL.	
	Examiner Jason C. Smith	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 14, 15 and 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/14/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 01/14/2010 is being considered by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 recites the limitation "the upstanding wall" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of the art of record claim 22 will be treated as it depended from claim 21.

Claim Rejections - 35 USC § 103

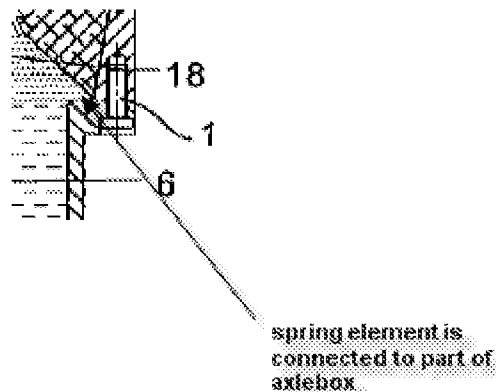
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-4, 7, 8, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gedenk (EP1369616) in view of SU1188033. Gedenk discloses at

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least one hydraulic spring (2) having a housing (4 and 10) being required for a functionality of said hydraulic spring, and at least a portion of a spring element (8 and 20) of the at least one hydraulic spring being provided in a hydraulic fluid (6) of the hydraulic spring. Gedenk shows a two part housing (4, 10), portion of a spring element (20) in the fluid (6), but does not disclose at least a part of an axlebox forming at least a part of said housing. However, '033 teaches using the cup shaped portion of the axlebox housing to form part of the housing of the hydraulic spring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the above disclosed in Gedenk in view of the teaching of '033. The motivation for doing so would have been to use the hydraulic spring of Gedenk to adapt to fit a railway bogie application; [claim 2] Gedenk discloses a cup shaped region (4) in figure 1; [claim 3] see figure 1; [claim 4] Gedenk discloses at least one hydraulic spring (2) having a housing (4) being required for a functionality of said hydraulic spring. '033 discloses at least a part of said axlebox forming at least a part of said housing as mentioned above. Gedenk discloses whereby a spring element (8, 20) of said hydraulic spring is directly connected to said part of said axlebox in combination. In comparison of figures 1 and 2 the spring element (8) is in direct contact to said part of said axlebox (see figure below). As discussed in the interview claim 4 is broader than as discussed because the elastomeric element is not in contact with the upstanding wall of the axlebox.

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[claim 7] the spring element (8, 20) comprises at least one elastomeric element (8);

[claim 8] axlebox (4) in combination forms at least a part of a boundary of a volume for a hydraulic fluid (6) of said hydraulic spring and said spring element (8, 20) comprises a centerpiece (20) which extends into said volume for said hydraulic fluid forming a plunger shaped region (22); [claim 13] Gedenk discloses at least one cup-shaped region (4); at least one hydraulic spring (2) adapted to be connected to a frame of the bogie in combination ('033 discloses how the hydraulic spring is connected to the bogie as described above); a spring element (8, 20) of the at least one hydraulic spring being secured directly to the axlebox (at 8) in combination to define together with the cup-shaped region (4) a volume for receiving a hydraulic fluid (see figure above). Parts 8, 20, and 4 together define a volume. The centerpiece (20) and elastomeric element (8) of spring element, along with part (10) and cup shaped part (4) form an enclosed volume which receives fluid (6). The claim does not require the hydraulic fluid to completely fill the volume or contact the elastomeric portion of the spring; [claim 17]

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note in the combination, centerpiece (20) would connect to the bogie at the upper part (12) of '033, see figure 1 of '033; [claim 19] when adapting the spring of Gedenk to a railway application there would be two springs as taught by '033.

6. Claims 9-12, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gedenk (EP1369616) in view of SU1188033 in view of Gedenk (2002/0089102). Regarding claims 9 and 18, The combination of Gedenk and '033 discloses the axlebox set forth above, but does not disclose the rigid elements. However, Gedenk '102 does disclose the rigid elements (see figure 1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the combination to include the rigid elements as taught by Gedenk '102. The motivation for doing so would have been to alter the properties of the spring; [claim 10] see figure 1 of Gedenk '102; [claim 11] see paragraph 20 of Gedenk '102. Regarding claims 11 and 12, the combination discloses the axlebox set forth above, but does not disclose the vulcanization. However, Gedenk '102 does disclose vulcanization between the spring element and the outer ring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include vulcanization in the combination as taught by Gedenk '102. The motivation for doing so would have been to provide an attachment means between the elastomeric elements and the rigid elements or the centerpiece. Note Gedenk '616 does not disclose an attachment means; the Gedenk '102 reference supplies an expected type suitable for use on Gedenk '616. Also, the elements of claim 12 are the same elements disclosed in the rejection of claim 8, except for the vulcanization; [claim 16] Gedenk '102 discloses a plurality of elastomeric elements. The

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elastomeric elements are secured to a portion of the cup shaped region of the axlebox as described in the rejection of claim 4 above.

Allowable Subject Matter

7. Claim 24 is allowed.
8. Claims 5, 6, 14, 15, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claim 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 05/10/2010 have been fully considered but they are not persuasive. In the interview summary it was discussed that the elastomeric element being immersed in the fluid that was allowable. In indicating claim 23 as allowable, the examiner did not appreciate the broad term "spring element" could encompass other elements other than the elastomeric elements. The examiner regrets any inconvenience. In order to expedite prosecution examiner reiterates the position in the interview that the elastomeric portion of the spring element being immersed in the fluid would overcome the art of record. Regarding applicant's paraphrasing of examiners' position in the rejection this is not entirely accurate; however the explanation in the

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office action of the examiner's combination was not clearly set forth due to typographical errors. In the combination, the examiner was not attempting to replace spring elements of '033 with the spring elements of Gedenk as applicant apparently thought. Rather as set forth in the introductory paragraph of this office action the examiner was utilizing the structure of Gedenk as the base and mainly relying of the '033 reference as an obvious teaching to adapt the spring of Gedenk for use in a railway bogie application. In doing so the cup shaped portion of the housing of Gedenk would form part of the axlebox as taught by '033. In reviewing the rejection of the previous office action the reference names were inadvertently mixed up, so applicant's confusion is understandable and sincerely regretted. Should applicant have any questions about the current rejection applicant is invited to contact examiner for clarification. Regarding applicant's assertion of limitations of claim 4 are not met by the combination the examiner respectfully disagrees as set forth in the rejection above. The elastomeric portion (8) of the spring element (8, 20) of Gedenk is directly connected to the cup shape portion (4) at the top flange thereof by virtue of being in contact where the corner flange portion of the cup shaped portion (4) meets upstanding part (10). This can clearly be seen by comparing figures 1 and 2 where as the spring moves downward more of the elastomeric part of the spring element comes in contact with the upper surface of the upper flange of the cup shaped part (4) as also seen in the figure above. As discussed in the interview, the examiner reiterates that claiming the spring element in direct contact with the upstanding wall of said part of said axlebox would be allowable over the art of record (see claim 21). Regarding claim 13 with direct contact of spring element to axlebox, see

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the arguments of claim 4. The volume of the hydraulic fluid, spring element (8, 20) and housing (4, 10) together clearly define an enclosed volume which receives hydraulic fluid which is all that is required in applicants' claims. The fact that said volume includes a space (18) that is not completely filled with fluid is irrelevant since applicant's claim does not require said volume to be completely filled with the fluid. In the interest of expediting prosecution, claiming said volume is completely filled with hydraulic fluid would overcome the art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Smith whose telephone number is (571) 270-5225. The examiner can normally be reached on M- F, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Joseph Morano/
Supervisory Patent Examiner, Art Unit 3617

/Jason C Smith/
Examiner, Art Unit 3617